

Appl. No. 10/767,961
Amdt. dated June 30, 2006
Reply to Office Action of January 3, 2006

Remarks and Arguments

Preliminary Matters:

In the Office Action of 3 January 2006, the Examining Attorney raised an issue regarding Applicant's right to take action in this case. In particular, the Examiner noted that the assignee's Statement under 37 CFR 3.73(b) was deficient. In response, Applicant/assignee, submits herewith (enclosed) a replacement Statement under 37 CFR 3.73(b) showing the full chain of title from the original inventors to the Applicant, which establishes its 100% ownership rights to the present application. It is respectfully submitted that such statement addresses the outstanding objection raised by the Examiner and, for this reason, Applicant respectfully requests withdrawal of this rejection.

Introduction to Substantive Issues:

Upon entry of this paper, claims 1-34 and 37-61 are pending in the above-identified application. Claims 1-7 have already been allowed. Claims 8-17 are currently rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. Claims 22-25, 33, and 35-36 are currently rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. By this amendment, claims 35-36 have been canceled with prejudice. Claims 8-17 are currently rejected under 35 U.S.C. §251 as claiming subject matter in the reissue application that was canceled in response to a restriction requirement during prosecution of the original patent, U.S. Pat. No. 6,011,772. Claims 8-17, 22-25, 33, and 35-36 are currently rejected under 35 U.S.C. §251 as being based upon new matter added to the patent for which reissue is sought. Claims 18-61 are currently rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the patent reissue is based.

Rejection of Claims under 35 U.S.C. §112, first paragraph

Claims 8-17 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, Examiner alleged that claim 8

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does not support an optical media with two substrates and a reservoir holding fluid. Claim 8 has been amended to more clearly point out what is claimed. Claim 8 has been amended to omit all reference to a second substrate. However, Applicants firmly assert that the specification clearly discloses a substrate in which the encoded feature (pits and spaces) is placed on top of which a reflective layer is deposited, and then there is a protective layer of transparent plastic (i.e., substrate) used to cover the reflective layer. Specifically, for example, the disc of Fig. 16 includes a substrate 10, covered with a reflective layer 14, which is in turn covered with a protective layer 16. Claims 9-17 depend from claim 8. In light of the amendments to claim 8 and the above remarks, claims 9-17 are also believed allowable for the same reasons.

Claims 22-25, 33 and 35-36 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. With respect to claims 22-25, Examiner alleges that the prior patent does not describe dye as a limiting agent. However, the specification clearly discloses, for example, at col. 7, lines 56-67 and Table 2, the use of dyes as reading-inhibit agents. The compounds listed in Table 2 are representative examples of dyes, which are well known in the art to be dyes. In light of the above remarks claim 22 is believed allowable. Claims 23-25 depend from claim 22. In light of the above remarks, claims 23-25 are also believed allowable for the same reasons as claim 22.

The Examiner rejected claim 33 because the prior patent does not describe a photolytic. Claim 33 has been amended to include the limitation of a reading-inhibit agent that is activated by optical radiation. The specification clearly discloses chemical decomposition induced by light or radiant energy. Examples of this disclosure may be found at column 10, line 7 through column 11, line 5. The term photolytic is well known in the art. In light of the above remarks, claim 33 is believed allowable.

Claims 35-36 have been cancelled herein.

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Rejection of Claims under 35 U.S.C. §251

Claims 8-17 were rejected under 35 U.S.C. §251. The Examiner alleged that the Applicants claimed subject matter in the reissue application that was canceled in response to a restriction requirement during prosecution of the original patent, U.S. Patent No. 6,011,772 (hereafter the "772 patent"). The '772 patent prosecution shows that the Examiner actually allowed the originally filed claims that were canceled in response to the restriction requirement. Specifically, in the February 23, 1999, response to the February 2, 1999 Office Action, the Applicants elected species IX, corresponding to Figure 12. The Applicants submitted that claims 8, 9, 12, 13 and 15 read on that elected species. However, in subsequent prosecution, claims 1-22 (as well as new claims 23-26) were re-introduced into the application (see Office Action dated June 29, 1999.). As a result, the "non-elected" claims were not canceled and the Examiner rejection in the present reissue application is not proper. For the above reasons claims 8-17 are believed allowable.

Claims 18-61 were rejected under 35 U.S.C. §251. The Examiner alleged that claims 18-61 are an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based. Specifically, the Examiner argues that claim 18 fails to claim a "short effective life for the disc". In response, claims 18 and 48-61 have been amended to include the limitation of a short effective life. Claims 19-34 and 37-49 depend from claim 18 and for the same reasons claim 18 is believed allowable, claims 19-34 and 37-49 are also believed allowable.

CONCLUSION

Applicants respectfully request an early and favorable reconsideration and allowance of this application, as amended herein. With submission of the replacement Statement under 37 CFR 3.73(b), Applicant submit that it has all right and title to pursue

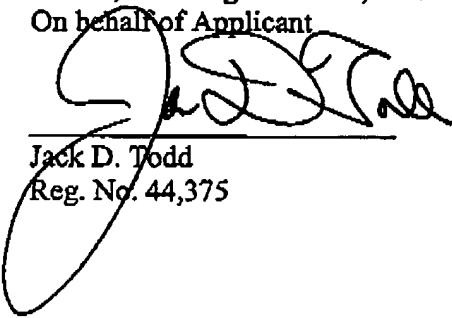
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this application. In addition, with entry of this Amendment, Applicant submits that all claims are now in a condition for allowance, which action is earnestly solicited. With entry of this amendment claims 1-34 and 37-61 are pending.

This communication is responsive to the Office Action mailed on 3 January 2006, to which a response is due on or before 3 July 2006, with the submission of a petition for a three-month extension of time and the requisite fees. It is not believed that any other fees are due; however, please charge any fees that might be due or credit any overpayment to our Deposit Account No. 50-3537.

Respectfully submitted,
Morris, Manning & Martin, LLP
On behalf of Applicant

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